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10/645,484	08/22/2003	Hitoshi Nishimura	500.37529CC3	8733

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EXAMINER

RODRIGUEZ, WILLIAM H

ART UNIT	PAPER NUMBER
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3746

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,484

Applicant(s)

NISHIMURA, HITOSHI

Examiner

William H. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/391,088.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/22/03, 1/30/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS filed on 4/21/04

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:

In claim 1 line 3 delete the phrase "a casing a meshed" and insert --a casing and meshed-- before "with" and after "in". Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,287,088. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

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Claim 1 of the instant application is merely broader than claim 1 of the patent. Claim 1 of the instant application recites the following elements: *a compressor main body, a male rotor, a female rotor, a casing, first and second bearings, a high speed motor, a high frequency inverter, a motor shaft, and a third bearing*. While, claim 1 of the patent recites the following elements: *a compressor main body, a male rotor, a female rotor, a casing, first and second bearings, a first shaft sealing apparatus, a second shaft sealing apparatus, a compression chamber, a high speed motor, a high frequency inverter, a suction side, a motor shaft, and a third bearing*. Thus, the elements recited by claim 1 of the instant application are contained within claim 1 of the patent. On the other hand, claim 1 of the patent is more specific because it contains some features not present in claim 1 of the instant application. These features are: a first shaft sealing apparatus, a compression chamber and a suction side. Nevertheless, the more specific claim (claim 1 of the patent) "anticipates" the broader claim 2 of the instant application.

Claim 2 of the instant application is merely broader than claim 1 of the patent. Claim 2 of the instant application recites the following elements: *a compressor main body, a male rotor, a female rotor, a casing, first and second bearings, a first shaft sealing apparatus, a second shaft sealing apparatus, a compression chamber a high speed motor, a high frequency inverter, a motor shaft, and a third bearing*. While, claim 1 of the patent recites the following elements: *a compressor main body, a male rotor, a female rotor, a casing, first and second bearings, a first shaft sealing apparatus, a second shaft sealing apparatus, a compression chamber, a high speed motor, a high frequency inverter, a suction side, a motor shaft, and a third bearing*. Thus, the elements recited by claim 2 of the instant application are contained within claim 1 of the patent.

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On the other hand, claim 1 of the patent is more specific because it contains a feature not present in claim 2 of the instant application. This feature is: a suction side. Nevertheless, the more specific claim (claim 1 of the patent) "anticipates" the broader claim 2 of the instant application.

Claim 3 of the instant application recites the following elements: *a compressor main body, a male rotor, a female rotor, a casing, first and second bearings, a first shaft sealing apparatus, a second shaft sealing apparatus, a compression chamber, a motor, an inverter, a suction side, a motor shaft, and a third bearing.* While, claim 1 of the patent recites the following elements: *a compressor main body, a male rotor, a female rotor, a casing, first and second bearings, a first shaft sealing apparatus, a second shaft sealing apparatus, a compression chamber, a high speed motor, a high frequency inverter, a suction side, a motor shaft, and a third bearing.* Thus, the elements recited by claim 3 of the instant application are contained within claim 1 of the patent. Therefore, claim 1 of the patent "anticipates" the broader claim 3 of the instant application.

Claim Rejections - 35 USC § 102

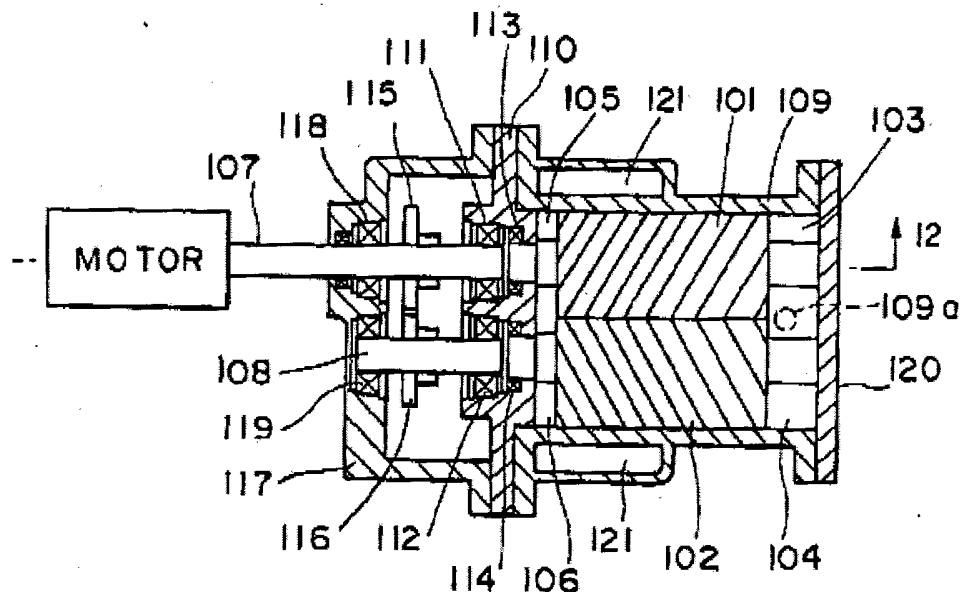
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by **Ozaki et al. (U.S. 5,674,063)**.

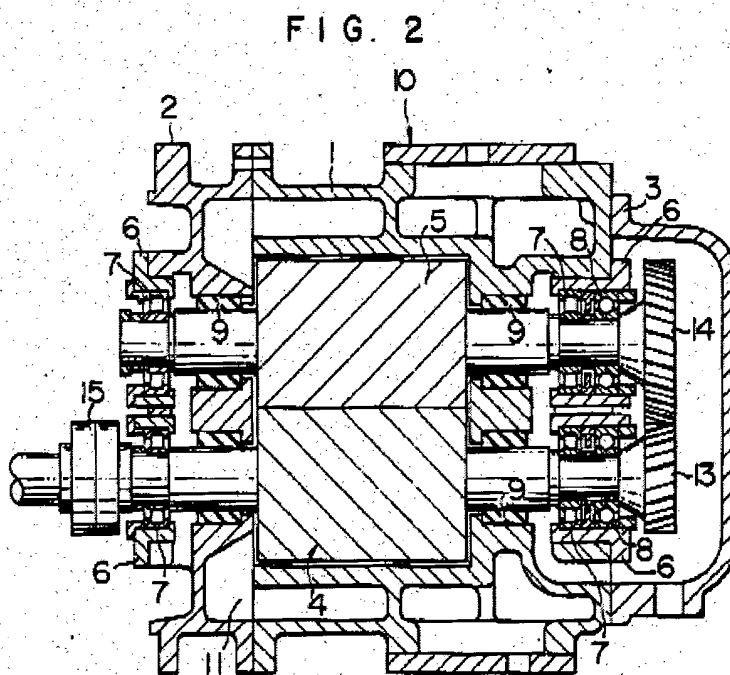
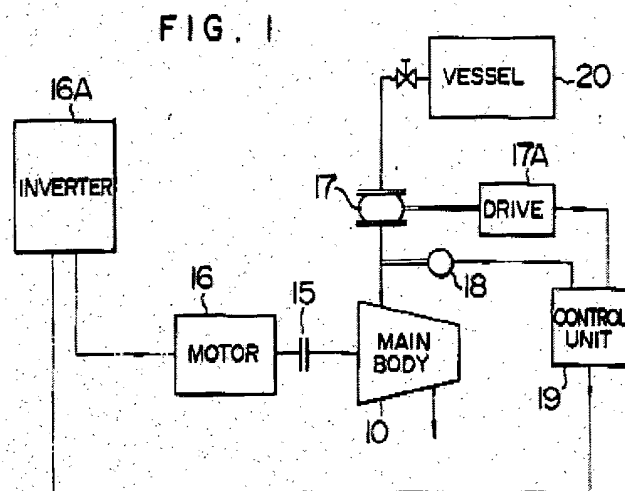
Fig. 11



Ozaki teaches a screw compressor comprising: a compressor main body having a male rotor 101 and a female rotor 102 which are received in a casing a meshed with each other, first and second bearings 113, 114 for supporting the male rotor and the female rotor and a high speed motor driven by a high frequency inverter 202, said high speed motor having a motor shaft 107 in which the motor rotor is formed, a third bearing 118 for rotating and supporting the motor shaft, said first, second and third bearings being made the same with respect to each other. See particularly **Figure 11**, column 6 lines 6-8 of Ozaki.

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4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by **Uchida et al. (U.S. 4,664,601)**.



Uchida teaches a screw compressor comprising: a compressor main body having a male rotor 4 and a female rotor 5 which are received in a casing a meshed with each other, first and

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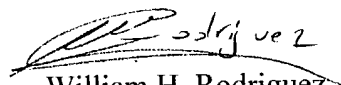
second bearings 8 for supporting the male rotor and the female rotor and a high speed motor 16 driven by a high frequency inverter 16A, said high speed motor having a motor shaft in which the motor rotor is formed, a third bearing 7 for rotating and supporting the motor shaft, said first, second and third bearings being made the same with respect to each other. See particularly **Figures 1, 2**, column 3 lines 64-66 of Ozaki.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Rodriguez whose telephone number is 703-605-1140. The examiner can normally be reached on Monday-Friday 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R Yu can be reached on 703-308-2675. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William H. Rodriguez
Examiner
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